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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,819	06/25/2001	Robin S. Gray		9738

7590 01/14/2005

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EXAMINER	
LIU, MING HUN	
ART UNIT	PAPER NUMBER
2675	

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/888,819	GRAY, ROBIN S.	
	Examiner	Art Unit	
	Ming-Hun Liu	2675	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-34 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-34 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-10, 12, 21, 22, 24-29, 31, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of US Patent 5,327,161 to Logan and US Patent 5,805,144 to Scholder et al.

3. In reference to claims 1, 6, 10, 12, 24-28, 33, 34 as mentioned in the previous office action 5/11/04 that Logan teaches a touch pad integrated into a cavity of mechanical button. However, Logan does not teach integrating the mechanical button with a handheld mouse system. Scholder however does teach an integrated handheld mouse system that includes a touch pad as a separate cursor moving means (column 3, lines 8-28 and column 2, lines 14-29) - the user does not need to reposition the mouse housing in order to reposition the screen cursor, an action that can be satisfied by the track pad. On skilled in the art could combine the two inventions by placing Logan's touch pad/button onto the mouse disclosed by Scholder. It would have been obvious to combine track pad/mouse button with a complete physical mouse as taught by Logan on column 3, lines 8-28 and column 2, lines 14-29, the combination allow for superior cursor movement control.

In reference to claims 2, 5 and 7, Logan states in column 4, line 4 that the switch is a press button. By inherency that press button is triggered from the application of pressure.

In reference to claims 3,4, 8 and 9 Logan understands that the press button can be of several types well known to the art (column 3, lines 65-66). It would have been obvious to one skilled in the art to choose a press and lock button or a sliding panel button as the preferred embodiment if such substitutions improved on the user-friendliness of Logan's invention. Furthermore, Logan explains that the push button may be programmed to include a "button down" position to maintain the drag function (column 2, lines 6-10).

In reference to claims 21 and 22, the limitations placed in these claims are inherent to the type of buttons listed.

In reference to claim 29, as one skilled in the art understands, backlighting a button after it has been pressed is a feature that is well known to the art. It would have been obvious to include a light to inform the user of the button being pushed.

In reference to claim 31, the original Scholder invention allow of such a modification of having a touch pad, not on the top of a mechanical button.

4. Claims 11 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Logan and Scholder in view of US patent 5,530,455 to Gillick et al.

In reference to claims 11 and 30, Logan and Scholder teaches an invention that is similar to the one being claimed.

However, Logan does not go as far as to include a side button/touch pad t the sidewall of the mouse. Gillick on the other hand, does teach the addition of a side button.

One skilled in the art understands that additional buttons can be added to the mouse in various positions that seem most natural to a hand's grip. Placing a button/touch pad at the side of a mouse is an addition that does not change the complex circuitry, but rather just the psychical position of an element.

It would have been obvious to one skilled in the art to include an additional button on the side of the mouse, because that is the position where the thumb naturally rests and allows for an additional command method.

5. Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiang US Patent 5,973,622 in view of Logan.

In reference to claim 13 and 17, it can be seen from figures 1 and 2 of Chiang that his invention teaches a computer input device that allows for directional tracking using a track ball and vertical pushing of the button, where the tracking device is integrated into the cavity of the push button.

Chiang's invention includes a track ball, but not a track pad. As one skilled in the art understands the two are essentially interchangeable input methods. If however the applicant is unsatisfied with such a stipulation please refer to Logan's reference where a track pad/button is used.

Claims 15 and 16 are rejected with the same reasoning presented in the rejection of claims 3 and 4.

6. Claims 18-20 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable Chiang in view of Logan and further in view of US Patent 5,473,347 to Collas et al.

In reference to claims 18-20 and 32, teaches a system that is resembles the claimed invention however he does not incorporate his invention onto the sidewall of a keyboard.

Much like the reasoning offered in the rejection of claim 11, placing mouse buttons on the sidewall of a computer keyboard is also very customary in the art.

As Collas describes in the abstract of his invention, mouse buttons can be placed on the side of the keyboard for simpler, no natural feel for the user.

7. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Logan the combination of US patent 5,936,555 to Zagnoev.

In reference to claim 23, Logan teaches a mouse system with a mechanical button that is similar to the one being claimed. However Logan does not teach the incorporation of the mouse onto a computer keyboard.

Zagnoev's invention demonstrates the well-known combination of a mouse embedded onto a keyboard.

A mouse can be easily integrated into a keyboard, simply by combining the circuitry and housing of the two disjoint components.

It would have been obvious to one skilled in art to add a mouse onto a keyboard because of its extreme conventionality and the added value of space-saving and convenience factors.

Response to Arguments

8. Applicant's arguments with respect to claims 1-34 have been considered but are moot in view of the new ground(s) of rejection. The majority of the applicant's invention is anticipated by Logan's disclosure. Scholder teaches the combination of a mouse with a track pad/button assembly. Chiang teaches the combination on an aux keyboard. The references demonstrate that such inventions and combinations are well-known in the art.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ming-Hun Liu whose telephone number is 703-305-8488. The examiner can normally be reached on Mon-Fri.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ming-Hun Liu

HUY NGUYEN
SUPERVISORY EXAMINER